

Docket No.: 02559/100F420-US1
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Moshe Zilberstein, et al.

Confirmation No. 5469

Application No.: 09/422,387

Art Unit: 2155

Filed: October 21, 1999

Examiner: K. Q. Dinh

For: SYSTEM AND METHOD FOR PROCESSING
AND PRESENTING INTERNET USAGE
INFORMATION TO FACILITATE USER
COMMUNICATIONS

RESPONSE TO THE NOTICE OF NON-COMPLIANT APPEAL BRIEF

MS Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Responsive to the Notice mailed November 24, 2006, entry of the Amended
Appeal Brief submitted concurrently herewith is respectfully requested.

The Notice indicates that the Appeal Brief filed January 30, 2006 is non-compliant for not containing items required by 37 C.F.R. § 41.37(c). In particular, the Notice indicates that the Summary of Claimed Subject Matter did not contain a concise explanation of each independent claim involved in the appeal.

Appellants submit that the Amended Appeal Brief, submitted herewith, is fully compliant with the requirements of 37 C.F.R. § 41.37. Each and every point raised in the Notice of Non-Compliant Appeal Brief, has been addressed in this Amended Appeal Brief.

This response to the Notice of Non-Compliant Appeal Brief, and the Amended Appeal Brief, concurrently submitted herewith, should be considered because they are both being filed within thirty days of the mailing of the Notice and, thus, no fee is due. However, the Commissioner is hereby authorized to charge any fees deemed required in connection with this submittal to Deposit Account No. 04-0100.

Appellants note that a November 16, 2006 Order Returning Undocketed Appeal To Examiner requires the Examiner to consider Information Disclosure Statements filed on December 15, 2000 and December 3, 2003, and further requires the Examiner to provide written notification to the Appellants. Such written notification has not yet been received by Appellants.

Dated: December 22, 2006

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Richard J. Katz', is written over a horizontal line.

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Dated: _____

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APPELLANTS' AMENDED BRIEF ON APPEAL UNDER 37 C.F.R. § 41.37

MS Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Appellants submit this brief in accordance with 37 C.F.R. § 41.37 in support of their appeal from the Final Office Action, mailed June 13, 2005 by Examiner Khanh Q. Dinh, and the Notice of Panel Decision from Pre-Appeal Brief Review, mailed January 5, 2006, in the above-identified patent application.

In accordance with the Pre-Appeal Brief Conference Pilot Program, "the period of time for filing the appeal brief will be the later of the two-month period set in 37 C.F.R. § 41.37(a) or one month from the mail date of the decision on the request." See USPTO OG Notice: July 13, 2005. Therefore, Appellants submit that this Appeal Brief is timely filed, and requires no extension of time fees. However, the Commissioner is hereby authorized to charge any unpaid fees deemed required in connection with this Appeal Brief, or to credit any overpayment, to Deposit Account No. 04-0100.

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In accordance with 37 C.F.R. §§ 41.31 and 41.37, this brief follows the November 14, 2005 filing of a Notice of Appeal and payment of the required fee. This brief is in support of said Notice of Appeal.

I. REAL PARTY IN INTEREST

The real party in interest for this appeal is Comverse, Ltd. The inventors have assigned their rights in and to this application to Odigo, Inc., such assignment having been duly recorded. Comverse, Ltd., is a successor-in-interest to Odigo, Inc.

II. RELATED APPEALS AND INTERFERENCES

To appellants' knowledge, there are no other appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in this appeal.

III. STATUS OF CLAIMS

Claims 7-11, 14, 15 and 20-26 are pending in the application.

This appeal is in respect of the rejection of claims 7-11, 14, 15 and 20-26.

There are 14 claims pending in the application, *i.e.*, claims 7-11, 14, 15 and 20-26. They are reproduced in the **Claims Appendix**. The current status of the application's claims is as follows:

1. Claims canceled: 1-6, 12-13 and 16-19;
2. Claims withdrawn from consideration but not canceled: none;
3. Claims pending: 7-11, 14, 15 and 20-26;
4. Claims allowed: none;

5. Claims rejected: 7-11, 14, 15 and 20-26.

Claims 7-11, 14, 15 and 20-26 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,381,635 to Hoyer et al. ("Hoyer") in view of U.S. Patent No. 6,578,078 to Smith et al. ("Smith").

The claims on appeal are claims 7-11, 14, 15 and 20-26.

For the purpose of the present appeal, Appellants request that claims 7-11, 14, 15 and 20-26 be considered to form a single group.

IV. STATUS OF AMENDMENTS

No amendments have been filed subsequent to the June 13, 2005 Final Office Action.

V. SUMMARY OF CLAIMED SUBJECT MATTER

The claimed invention is directed to a system and method for providing information about the usage of Internet web sites and pages. In accordance with the claimed invention, a central server constantly monitors usage data for the designated web site and, when the user is online, provides such usage data for display to the user, preferably in a separate monitor window. The usage information is presented to the user while the user is connected to any other website.

Independent method claim 7 is directed to "providing usage information of a first web site designated by a user," (Specification, page 46, lines 20-23), and recites "receiving, from the user, a designation of the first web site as a monitored website" and "monitoring usage of the monitored website," (Specification, page 47, lines 1-8). The claim further includes the step of "transmitting data representative of the usage to the user by way of a monitor window" (Specification, page 47, lines 14-17.) Independent claim 14 is directed to a computer-readable medium encoded with processing instructions for implementing the method of claim 7. (Specification, page 46, line 20 bridging page 47, line 22.) Independent method claim 21 is directed

to similar subject matter as method claim 7, and recites “monitoring at least one other user’s usage of the monitored website.” (Specification, page 47, lines 8-12 and lines 20-22.)

Independent claim 15 recites an apparatus for providing usage information that includes a processor and a memory containing processing instructions. The processing instructions are configured to “receive, from the user, a designation of the first web page as a monitored website,” monitoring usage of the monitored website,” and “transmitting data representative of the usage to the user by way of a monitor window” (Specification, page 46, line 20 bridging page 47, line 22.)

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

1) Whether claims 7-11, 14, 15 and 20-26 can properly be rejected as obvious under 35 U.S.C. § 103(a) based on the combination of Hoyer and Smith.

2) Whether Hoyer and Smith provide the requisite motivation to combine the references to properly reject claims 7-11, 14, 15 and 20-26 as obvious under 35 U.S.C. § 103(a).

VII. ARGUMENT

Grounds of Rejection No. 1

The combination of Hoyer and Smith results in a system that fails to transmit data representative of usage information for a website to a user by way of a monitor window when the user is connected to any other website on a communication network. Thus, combining Hoyer and Smith does not result in the claimed invention.

Appellants submit that Hoyer discloses a method and apparatus for displaying multiple performance measurements of a web site. Hoyer discloses a performance monitor 200 that allows an administrator to assess the performance of Internet web sites (*e.g.*, CPU utilization, web server response time, web server hit count and rate). Specifically, “[t]he performance monitor 200 includes a client side component 210 and a server side component 225. As depicted, the client side

component 210 is coupled to the server side component 225 via the Internet.” See Hoyer, column 7, lines 22-29; and Fig. 3 (emphasis added). Hoyer merely discloses that the client side component 210 receives performance data from the server side component 225 to which it is connected, *i.e.*, the server provides data for a website to the client only when the client is connected to that website.

The Examiner acknowledges Hoyer’s narrow disclosure, and specifically states that Hoyer does not disclose “transferring data to [a] user when [the] user [is] connected to other web sites.” See June 13, 2005 Final Office Action, item 3, page 3. However, the Examiner cites Smith as providing those features of the claimed invention missing from Hoyer.

Appellants submit that Smith discloses a method for maintaining the integrity of URL references (*i.e.*, hyperlinks) to resources embedded within web sites. The resources themselves are not website usage information, but rather web pages, documents, static content, etc. Smith addresses the problems associated with broken hyperlinks for resources that have changed their location. When a server receives a message from a client requesting a resource via its URL reference, the server looks up the location of the resource in an indirection table, obtains a hyperlink to its current location, and forwards a copy of the resource to the client. The indirection table contains entries that map a URL to each resource. As resources are moved or deleted, their indirection table entry must be updated. Smith, column 11, lines 48-63.

The Examiner contends that Smith discloses “transferring data to [a] user when [the] user is connected to other web sites,” and cites Smith, column 11, line 13 through column 12, line 67 as support for this premise. Appellants respectfully disagree that the cited portion discloses transferring data to a user connected to other web sites. The cited portion discloses “each of the pages (documents) on a web site is typically stored as an individual HTML file on the web site’s server.” Smith, column 11, lines 13-15. The cited portion also discloses “the server looks up the location of the resource in the indirection table, and then forwards a copy of the resource to the client.” Smith, column 11, lines 59-61. However, the cited portion does not support the Examiner’s contention that data is transferred to a user connected to another website. Appellant further submits

that even, assuming *arguendo*, if such disclosure was present in Smith, the combination would not result in the claimed invention.

Pending independent claims 7, 14 and 15 each recite “transmitting data representative of the usage to the user **by way of a monitor window when the user is connected to any other website on the communication network.**” Emphasis added. Independent claim 21 recites similar subject matter.

Combining Hoyer and Smith results in a system that transmits performance measurements to a client connected to the web site being monitored, and will also forward static resources (*e.g.*, web pages and documents) in response to the client activating hyperlinks embedded in the web site, where the combination tracks changes to the location of the resources identified by the hyperlinks in an indirection table. Appellants submit that the combination of Hoyer and Smith does not result in a system that “transmit[s] data representative of the usage to the user by way of a monitor window when the user is connected to any other website on the communication network,” as recited in the claimed invention. Thus, the combination of Hoyer and Smith does not result in the claimed invention. Therefore, the Examiner has failed to meet the burden of establishing a *prima facie* case of obviousness.

Grounds of Rejection No. 2

While Hoyer discloses displaying multiple performance measurements of a website to a client connected to the website, and Smith discloses a method for maintaining the integrity of URL hyperlinks to static data embedded within websites, there is no motivation within either reference to combine them.

According to the Examiner, a person of ordinary skill in the art at the time of the invention would look to modify Hoyer in view of Smith in order to extend Hoyer to provide usage information on a website to a user connected to any other website; a feature which the Examiner acknowledges is missing from Hoyer. The Examiner contends that Smith is “in the same usage monitoring environment” as Hoyer. (June 13, 2005 Office Action, page 3.)

Appellants disagree with the Examiner's characterization that Hoyer and Smith are "in the same usage monitoring environment." While Hoyer monitors dynamic performance usage of a website, Smith relates to maintaining the currency of URL hyperlinks pointing to documents, web pages, and other static content. Smith does not disclose or suggest monitoring performance usage information for a website, nor does Smith disclose or suggest "transmitting data representative of the usage [information] to the user by way of a monitor window," as recited in the claimed invention. Thus, Appellants respectfully submit that Hoyer and Smith are not in the same usage monitoring environment, as is contended by the Examiner.

In considering obviousness, the critical inquiry is whether something in the prior art as a whole suggests the desirability, and thus the obviousness, of making a combination. *In re Newell*, 891 F.2d 899, 901-02, 13 U.S.P.Q. 2d 1248, 1250 (Fed. Cir. 1992). The Examiner must show some objective teaching from the art that would lead an individual to combine the references, *i.e.*, there must be motivation. In particular, "[t]he mere fact that the prior art may be modified in the manner suggested by the examiner does not make the modification obvious unless the prior art suggested the desirability of the modification." *In re Fritch*, 972 F.2d 1260, 23 U.S.P.Q. 2d 1780, 1783 (Fed. Cir. 1992) (emphasis added). The Court of Appeals for the Federal Circuit has stated: "selective hindsight is no more applicable to the design of experiments than it is to the combination of prior art teachings. There must be a reason or suggestion in the art for selecting the procedure used, other than the knowledge learned from the Appellant's disclosure." *In re Dow Chemical Co.*, 5 U.S.P.Q. 2d 1529, 1531 (Fed. Cir. 1988) (citations omitted).

As demonstrated above, Appellants submit that the Examiner has not shown any objective teaching from the cited art that would lead an individual to combine Hoyer and Smith. A person of ordinary skill in the art in possession of Hoyer at the time of the invention would not be motivated to look to Smith's teaching regarding maintaining an indirection table of URL hyperlinks to solve the problem of providing a user with performance usage information of one website, while the user is connected to any website on a communication network. Therefore, the Examiner has failed to meet the burden of establishing a *prima facie* case of obviousness.

For all of the reasons set forth above, the rejections of claims 7-11, 14, 15 and 20-26 should be reversed. Appellants respectfully request that the application be remanded to the Primary Examiner with an instruction to withdraw the 35 U.S.C. § 103(a) rejections, and pass the case to allowance.

Respectfully submitted,

By 

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Dated: December 22, 2006

APPENDIXES

CLAIMS APPENDIX

The following is a copy of the claims involved in the appeal:

1-6. (Canceled)

7. (Previously Presented) A method for providing usage information of a first web site designated by a user, the method comprising:
receiving, from the user, a designation of the first web site as a monitored website, wherein the monitored website is any web site on a communication network;
monitoring usage of the monitored website; and
transmitting data representative of the usage to the user by way of a monitor window when the user is connected to any other website on the communication network.

8. (Previously Presented) The method of claim 7, further comprising:
displaying to the user the usage information in a graphical format.

9. (Previously Presented) The method of claim 7, further comprising:
displaying to the user the usage information in a text format.

10. (Previously Presented) The method of claim 7, wherein the usage information is displayed automatically to the user.

11. (Previously Presented) The method of claim 7, wherein the usage information is displayed only upon a command generated by the user.

12-13 (Canceled)

14. (Previously Presented) A computer-readable medium encoded with processing instructions for implementing a method for providing usage information of a first web site designated by a user, the method comprising:

receiving, from the user, a designation of the first web page as a monitored website wherein the monitored website is any web site on a communication network;
monitoring usage of the monitored website; and
transmitting data representative of the usage to the user by way of a monitor window when the user is connected to any other website on the communication network.

15. (Previously Presented) An apparatus for providing usage information of a first web site designated by a user, comprising:
a processor; and
a memory storing processing instructions for controlling the processor, the processor operative with the processing instructions to:
receive, from the user, a designation of the first web page as a monitored website wherein the monitored website is any web site on a communication network;
monitoring usage of the monitored website; and
transmitting data representative of the usage to the user by way of a monitor window when the user is connected to any other website on the communication network.

16-19 (Canceled)

20. (Previously Presented) The method of claim 7, wherein the usage information comprises of an indication of a most-popular next-visited web site for a plurality of users;
an indication of web sites visited by the plurality of users prior to visiting the first web site; and
an indication of when and for how long the plurality of users visited the first web site.
21. (Previously Presented) A method for providing usage information of a first web site designated by a first user, the method comprising:

receiving, from the first user, a designation of the first web site as a monitored website, wherein the monitored website is any web site on a communication network;

monitoring at least one other user's usage of the monitored website; and

transmitting data representative of the at least one other user's usage to the first user by way of a monitor window when the first user is connected to any other website on the communication network.

22. (Previously Presented) The method of claim 21, further comprising:
displaying to the first user the at least one other user's usage information in a graphical format.
23. (Previously Presented) The method of claim 21, further comprising:
displaying to the first user the at least one other user's usage information in a text format.
24. (Previously Presented) The method of claim 21, wherein the at least one other user's usage information is displayed automatically to the first user.
25. (Previously Presented) The method of claim 21, wherein the at least one other user's usage information is displayed in response to a command generated by the first user.
26. (Previously Presented) The method of claim 21, wherein the usage information comprises an indication of a most-popular next-visited web site for a plurality of users, an indication of web sites visited by the plurality of users prior to visiting the first web site, and an indication of when and for how long the plurality of users visited the first web site.

EVIDENCE APPENDIX

All evidence is in the record.

RELATED PROCEEDINGS APPENDIX

There are no related proceedings for this matter.